

## **REMARKS**

### **Rejection of Claims 1 and 3 under 35 U.S.C. § 102(b)**

Claims 1 and 3 have been rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by Brine U.S. Patent No. 5,075,115. The Examiner states that Brine “teaches polymers of lactic acid with a molecular weight of 2500-4500. Terpolymers with other hydroxyl carboxylic acids such as glycolic acid, ε-caprolactone and valerolactone are specified (col. 3, lines 28-32).”

The Examiner further states that “Pharmaceutically active agents are disclosed (col. 3, line 61)” and “Calcium sulfate is specified (col. 5, line 15).”

It is well established that anticipation requires that each and every limitation set forth in a claim be present, either expressly or inherently, in a single prior art reference. In re Robertson, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950 (Fed. Cir. 1999); Celeritas Techs. Ltd v. Rockwell Int’l Corp., 150 F.3d 1354, 1360, 47 USPQ2d 1516, 1522 (Fed. Cir. 1998); Verdegaal Bros., Inc. v. Union Oli Co., 814 F. 2d 628, 631, 2 USPQ3d 1051, 1053 (Fed. Cir. 1987); Lindemann Maschinenfabrik GMBH v. American Hoist and Derrick Co., 730 F. 2d 1452, 1458, 221 USPQ 481, 485 (Fed. Cir. 1984).

Here, Brine (U.S. Patent No. 5,075,115) does not mention “water solubility” or “adhesive strength” at all. Claims 1 and 3 specify that the claimed polymers have an “adhesive strength of about 600 to about 150,000 Pa so that the matrix is tissue adherent” and a “water solubility of about 0.01 to about 500 mg/ml at about 25°C.” The examiner has not demonstrated that the polymers disclosed in Brine have an adhesive strength of about 600 to about 150,000 Pa and a water solubility of 0.01 to about 500 mg/ml at about 25°C. As discussed above, anticipation requires that each and every limitation set forth in a claim be present in the applied prior art.

The specification disclosed that the adhesive strength (Pa) is manipulated by changing the homopolymer and/or the molecular weight of the polymer. Specification, pp. 19-22. The examiner has not pointed to any teaching in Brine which establish that the polymers taught

therein exhibit the claimed adhesive strength. Nor does the examiner make any mention of the water solubility of the compounds disclosed in the patent.

Accordingly, Brine cannot anticipate claims 1 and 3. Withdrawal of the rejection of claims 1 and 3 under 35 U.S.C. § 102(b) is respectfully requested.

#### Rejection of Claim 2 under 35 U.S.C. § 102(b)

Claim 2 is rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by Domb, U.S. Patent No. 4,88,413. In that regard, the Examiner states that “Domb teaches a composition comprising a polymer (title). Adhesion is specified (col. 4, line 66). Biodegradability is specified (claim 1). Growth factors are disclosed (col. 2, line 27).” The Examiner further incorporates the inherency argument from claims 1 and 3 herein.

As discussed above, anticipation requires that each and every limitation set forth in a claim be present in the applied prior art. Here, Domb (U.S. Patent No. 4,888,413) does not mention “water solubility” at all. Claim 2 requires that the claimed polymers have a “water solubility of about 0.01 to about 500 mg/ml at about 25°C.” The examiner has not demonstrated that the polymers disclosed in Domb have a water solubility of 0.01 to about 500 mg/ml at about 25°C.

Accordingly, Domb cannot anticipate claim 2. Withdrawal of the rejection of claim 2 under 35 U.S.C. § 102(b) is respectfully requested.

#### Double Patenting Rejection of Claims 1-3

Applicants submit herewith a terminal disclaimer to obviate the provisional double patenting rejection over co-pending application serial number 09/923,118.

### CONCLUSION

Claims 1-3 are pending in the application. In view of the foregoing amendments and remarks, it is submitted that this application is in condition for allowance. Action to that end is hereby requested.

In the event that there are any questions related to this response in particular, or to the application in general, the undersigned would appreciate the opportunity to address those questions directly in a telephone interview to expedite the prosecution of this application for all concerned.

Respectfully submitted



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